

REMARKS

In the Office Action mailed 5/22/2003, Claims 7 and 9 were objected to for informalities. Claims 1-4, 8 and 14-16 were rejected as being anticipated by the prior art under 35 U.S.C. §102(b). Claims 9-11 were rejected as being obvious over the prior art under 35 U.S.C. § 103. The drawings and specification further were objected to. Claims 5-7, 12-13 and 17-18 were objected to, but were further indicated as being allowable.

Applicant has herein amended the drawings and specification to overcome the Examiner's objections. Claims 2 and 9 have been canceled. Claims 1, 3, 7, 8 and 10 have been herein amended.

Anticipation Rejections

Claims 1 - 4, 8 and 14 - 16 were rejected under 35 U.S.C. §102(b) as being anticipated by Clarke. Applicant respectfully traverses the rejection of these claims, as amended, over Clarke, for the reasons set forth below after a discussion of the teachings of this reference.

O.H. Clarke, U.S. Patent No. 1,571,709

Clarke is a "Spot or Search Light Assembly." In addition to other elements, the Clarke assembly has a "lamp casing 14" that attaches to the vehicle (in part) by a "ball or sphere 3" "formed with an integral boss 11 at its outer side" via a "diametrical bore 12" that extends "through the sphere," "the forward end of which is passed through a hole in the

lamp casing 14 and receives a nut 15 by which the lamp casing 14 is securely clamped against the outer face of the boss 11." *Page 1, Line 101 – Page 2, line 5.*

In summary, then, the "lamp casing" attaches to the "sphere" by a "nut" attached to a threaded "diametrical bore" extending through the "sphere" and into the "lamp casing."

Patentability of Claims 1, 3-4, 8 and 14-16 (as amended)

By combining the elements of various well-known decisions, one can see that a prima facie case of anticipation is established only when the Examiner provides:

1. a single reference¹
2. that teaches or enables²
3. each of the claimed elements (arranged as in the claim)³
4. expressly or inherently⁴
5. as interpreted by one of ordinary skill in the art.⁵

If the Examiner fails to produce a prima facie case of unpatentability, "then without more the applicant is entitled to the grant of the patent."⁶

The subject claims all recite the following limitation:

"said ball dome member is further defined by a cylindrical portion, said cylindrical portion terminating in a dome portion at one end and in an annular face at

¹ *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

² *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964)).

³ *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ at 485.

⁴ *Continental Can Co. USA v. Monsanto Co.*, 20 USPQ 2d at 1749-50.

⁵ *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

⁶ *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992).

another end, said annular face defined by one or more threaded bores formed therethrough" [*emphasis added*].

The "nut" attaching to the "diametrical bore" of Clarke is clearly different structure than the "threaded bores" of the "dome" of Applicant's device. In Clarke, the elements attach by a nut engaging a threaded rod extending into the "lamp casing;" in Applicant's invention, the elements attach by threaded bolts engaging the ball dome member (the threaded bores formed therein). As discussed in the specification, Applicant's design choice was intentional to solve strength and aesthetic problems in the prior art; as such these structural distinctions are not *di minimus*. Since each and every element of Applicant's Claims is not found in Clarke, the Examiner has failed to make out a prima facie case of anticipation, and these claims (as amended) must be allowed.

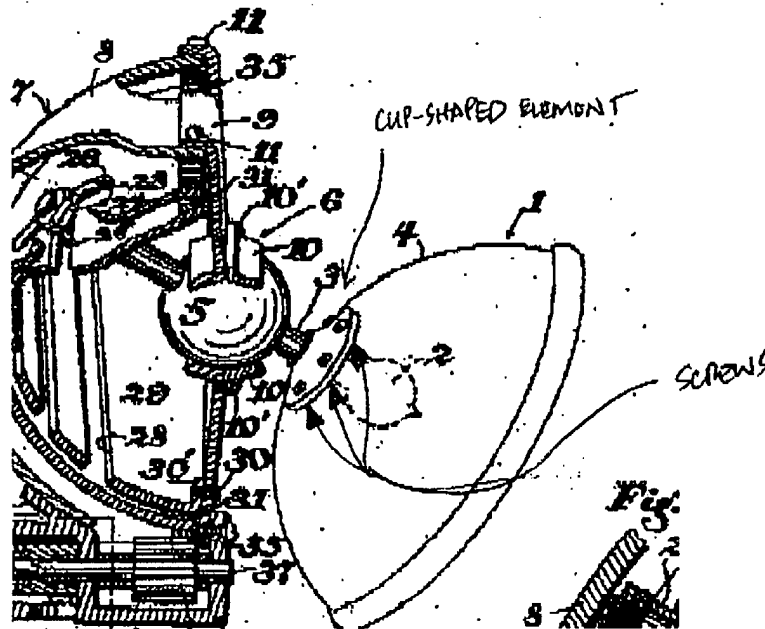
Obviousness Rejections

Claims 9 - 11 were rejected under 35 U.S.C. § 103 as being obvious over the combination of Clarke and Gehersky. Applicant respectfully traverses the rejection of these claims, as amended, over Clarke and Gehersky for the reasons set forth below after a discussion of the teachings of Gehersky.

W. W. Gehersky, U.S. Patent No. 1,612,806

Gehersky is an "adjustable spotlight" that includes, in pertinent part, "a spot light lamp 1" contained within a "casing 4," the "casing 4" extending from a "stem 3." The

"stem 3 is secured at one end in any well known way to the casing 4 of the spot-light lamp 1." *Page 1, Line 51 – 57.* Although no further text disclosure is provided on these particular elements and their interrelationship(s), Figure 3 depicts the "stem 3" interfacing with the "casing 4" by a cup-shaped element attached to the "casing 4" by a plurality of screws:



There is no disclosure of screws or bolts engaging threaded bores in the "stem 3" or the cup-shaped element.

Patentability of Claims 10 and 11 (as amended)

The Court has established that a prima facie case of obviousness is established only when the Examiner provides:

1. one or more references⁷
2. that were available to the inventor⁸
3. where the reference(s) teach⁹
4. a suggestion to combine or modify the reference(s)¹⁰
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.¹¹

Here, and as discussed above in connection with the anticipation argument for patentability, Applicant's claims 10 and 11 (as amended) recite elements and limitations that are different from both Clarke and Gehersky; namely, Applicant's Claim recites

"said ball dome member is further defined by a cylindrical portion, said cylindrical portion terminating in a dome portion at one end and in an annular face at another end, said annular face defined by one or more threaded bores formed therethrough" [*emphasis added*].

Nothing in Clarke or Gehersky, either alone or in combination, teaches similar structure. Specifically, Clarke teaches a threaded stem or bar, rather than threaded bores; Gehersky teaches screws engaging threaded holes in the housing itself, rather than any element approximating Applicant's "ball dome." As such, Clarke and Gehersky fail to teach, hint or suggest Applicant's novel and nonobvious device, and therefore the rejection of these claims is without basis, and they must be allowed.

⁷ *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

⁸ See *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

⁹ *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964).

¹⁰ *In re Lulu*, 747 F.2d 703, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

¹¹ *Rockwell Int'l Corp. v. United States*, 147 F.3d 1358, 47 USPQ 2d 1027, 1033 (Fed. Cir. 1998).

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests that the application be reconsidered, the claims be allowed, and the case passed to issue.

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ANNOTATED MARKED - HP DRAWINGS

Figure 4A

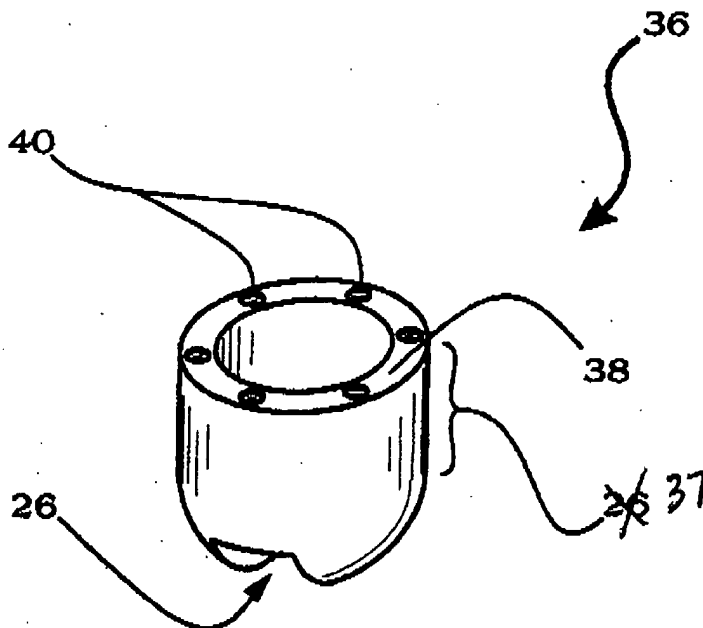


Figure 4B

